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EXAMINER

CHEUNG, MARY DA ZHI WANG

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* JEFFRY J. GRAINGER,
9 STEPHEN K. BOYER, AND
10 CECILY ANNE SNYDER
11

12
13 Appeal 2009-009582
14 Application 09/872,764
15 Technology Center 3600
16

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18 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
19 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.
20 FETTING, *Administrative Patent Judge*.

21 DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE²

Jeffrey J. Grainger et al.(Appellants) seeks review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-17, 38, and 39, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellants invented a way to prepare intellectual property documents (Specification 1:13-17). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A computer-implemented method for securing intellectual property rights, the method comprising:

- [1] providing, from a first server computer to a client computer,
an electronic invention disclosure form to be filled out;
- [2] actively prompting a user of the client computer
to provide information
corresponding to an invention
into pre-selected fields
of the electronic invention disclosure form;

² Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed November 6, 2008) and the Examiner's Answer ("Ans.," mailed January 16, 2009), and Final Rejection ("Final Rej.," mailed August 16, 2006).

1 [3] receiving a filled-out invention disclosure
2 in electronic form on the first server;
3 and
4 [4] automatically converting
5 the invention disclosure form
6 into a format of a patent application
7 in response to a single click instruction input
8 by the user
9 on the first client and
10 received by the server.

11 The Examiner relies upon the following prior art:

Whitmyer US 6,182,078 B1 Jan. 30, 2001

Hsu US 5,982,898 Nov. 9, 1999

12 U.S. Patent and Trademark Office, ePave User Guide, Jan. 12, 2000
13 (ePave)

14 U.S. Patent and Trademark Office, U.S. Patent Application Specification
15 Authoring Guide for WordPerfect XML Template, Dec. 14, 1999 (XML
16 Template)

17 Claims 1-3, 38, and 39 stand rejected under 35 U.S.C. § 102(a) as
18 anticipated by ePave.

19 Claims 4-8 and 11 stand rejected under 35 U.S.C. § 103(a) as
20 unpatentable over ePave.

21 Claims 12-14 stand rejected under 35 U.S.C. § 103(a) as unpatentable
22 over ePave and Whitmyer.

1 Claims 9-10 stand rejected under 35 U.S.C. § 103(a) as unpatentable
2 over ePave and Hsu.

3 Claims 15-17 stand rejected under 35 U.S.C. § 103(a) as unpatentable
4 over ePave and XML Template.

5 ISSUES

6 The rejections over art turn on the construction of the limitations
7 “server,” “converting,” and “electronic invention disclosure form” and
8 whether ePave describes the claims when these terms are given their
9 broadest reasonable interpretation.

10 FACTS PERTINENT TO THE ISSUES

11 The following enumerated Findings of Fact (FF) are believed to be
12 supported by a preponderance of the evidence.

13 *Facts Related to the Prior Art*

14 *Examiner Answer Findings*

15 01. We adopt the findings of fact described by the Examiner at
16 Answer 4-12.

17 *ePave*

18 02. ePave is directed to describing the Electronic Filing System
19 used by the USPTO. ePave 1: Introduction.

20 03. ePave has data entry fields for submitting the file name of a
21 biotechnology sequence listing for an invention disclosure. ePave
22 15-32.

04. ePave has data entry fields for submitting the invention title and inventor names and the name of a file containing a patent application specification for an invention disclosure. ePave 32-48.

05. ePave transmits the data to the USPTO after the user clicks an OK button. ePave 47.

Whitmyer

06. Whitmyer is directed to providing communications regarding professional services to clients. Whitmyer 2: Summary of the Invention.

Hsu

07. Hsu is directed to reducing the certification overhead problem in secure and authorized communications by separating identity verification from certificate issuing. Hsu 2: Summary.

XML Template

08. XML Template is directed to the information needed to author structured Specification documents for filing U.S. patent applications. XML Template 3:¶ 1.1.

ANALYSIS

Claims 1-3, 38, and 39 rejected under 35 U.S.C. § 102(a) as anticipated by ePave.

The Appellants contest the Examiner's findings as to each of the four limitations in claim 1. We agree with the Examiner's findings and adopt the

1 Examiner's findings of fact and analysis regarding claim 1. To clarify the
2 reasoning behind our agreement, we further find as follows.

3 As to limitations [1] and [2], the argument is primarily that ePave
4 describes no electronic invention disclosure form to be filled out. Appeal
5 Br. 8. The argument appears to imply that the form must contain entries for
6 everything in an invention disclosure. The phrase electronic invention
7 disclosure form is broader than that. The noun is modified by the phrase
8 invention disclosure, and the combined phrase is then modified by the word
9 "electronic." The phrase makes no limitation on the manner of modification.
10 Thus, any information pertinent to an invention disclosure would be the type
11 of information in an electronic invention disclosure form. As the Examiner
12 found, ePave at least has fields for the invention title and inventor names,
13 plus file names for files containing biotechnology sequence listings and
14 patent application specifications. FF 03 & 04. All of these items of
15 information are pertinent to an invention disclosure.

16 The Appellants next argue that the forms are from a stand alone
17 computer, rather than a server, and the forms are not submitted to the server
18 that the forms came from. Appeal Br. 9. As the Examiner found, ePave is
19 downloaded from the USPTO and the forms are submitted to the USPTO.
20 Since the forms are within ePave, the forms are downloaded when ePave is
21 downloaded. As to the single server argument, as the Examiner found, the
22 claims make no structural limitation on the scope of the server, and so the
23 USPTO Internet site, being a single logical unit that serves Internet requests
24 for both the ePave downloads and the requests to receive ePave forms, reads
25 on such a single server.

1 The Appellants next argue that ePave fails to receive a filled out form
2 and convert the form into the format of a patent application in response to a
3 single click. Appeal Br. 11-12. As the Examiner found, ePave transmits the
4 data entered into ePave in response to clicking a button. FF 05. The claim
5 makes no further limitation on the nature of the conversion, so the electronic
6 conversion of the data into a bit stream for transmission and complementary
7 conversion of that data back into a patent application format at the USPTO is
8 within the scope of the claimed converting.

9 As to claims 2 and 3 separately argued, each of these claims recites
10 active prompting of an inventor by the disclosure form to provide either best
11 mode or enablement information. The Appellants argue that the prompts in
12 ePave do not state such purposes. Appeal Br. 14. Again, the claims are
13 broader than as argued. The claims recite the purpose of the prompt, but not
14 the specific manner. As one of ordinary skill knows that statutory
15 requirements for a patent application, which include a specification that
16 contains the best mode where there is one, and an enabling disclosure,
17 ePave's data fields for submitting the Specification, with their textual cues
18 that the Specification is asked for, actively prompt for a disclosure that is
19 ready for submission, and so would meet the statutory requirements.

20 The Appellants rely on the arguments in support of claim 1 for the
21 remaining claims.

Claims 4-8 and 11 rejected under 35 U.S.C. § 103(a) as unpatentable over ePave.

The Appellants rely on the arguments in support of claim 1 for these claims.

*Claims 9-10 rejected under 35 U.S.C. § 103(a) as unpatentable over ePave
and Hsu.*

The Appellants rely on the arguments in support of claim 1 for these claims.

Claims 12-14 rejected under 35 U.S.C. § 103(a) as unpatentable over ePave and Whitmyer.

The Appellants rely on the arguments in support of claim 1 for these claims.

Claims 15-17 rejected under 35 U.S.C. § 103(a) as unpatentable over ePave and XML Template.

The Appellants rely on the arguments in support of claim 1 for these claims. The Appellants also argue that the art fails to describe the limitations added by each of these dependent claims. Appeal Br. 16.

These claims recite providing drawing tool icons to facilitate creation of figures to be included in the filled-out invention disclosure; active prompting of the inventor by the smart disclosure form to create figures depicting novel

1 aspects of the invention; and receiving as input a single click on a scan
2 button to cause a drawing to be scanned and included as a figure in the
3 filled-out invention disclosure form. Again, these claim limitations are
4 broader than as argued. Word Perfect used by XML Template contained
5 such drawing icons, the single click of the OK button as discussed supra also
6 causes the computer to scan all of the data contents for transmission,
7 including drawing data, and the prompting for the specification and
8 drawings discussed supra also prompts for such drawings to be created at the
9 USPTO site after having been transmitted as a bit stream. The claims make
10 no further limitation on the manner of the recited scanning or creation.
11 When a computer program reads data this is also referred to as scanning the
12 data. When the results from a data transmission are translated into viewable
13 data, such viewable data is created by the program.

CONCLUSIONS OF LAW

16 Rejecting claims 1-3, 38, and 39 under 35 U.S.C. § 102(a) as anticipated
17 by ePave is not in error.

18 Rejecting claims 4-8 and 11 under 35 U.S.C. § 103(a) as unpatentable
19 over ePave is not in error.

20 Rejecting claims 9-10 under 35 U.S.C. § 103(a) as unpatentable over
21 ePave and Hsu is not in error.

22 Rejecting claims 12-14 under 35 U.S.C. § 103(a) as unpatentable over
23 ePave and Whitmyer is not in error.

Rejecting claims 15-17 under 35 U.S.C. § 103(a) as unpatentable over ePave and XML Template is not in error.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1-3, 38, and 39 under 35 U.S.C. § 102(a) as anticipated by ePave is sustained.
- The rejection of claims 4-8 and 11 under 35 U.S.C. § 103(a) as unpatentable over ePave is sustained.
- The rejection of claims 9-10 under 35 U.S.C. § 103(a) as unpatentable over ePave and Hsu is sustained.
- The rejection of claims 12-14 under 35 U.S.C. § 103(a) as unpatentable over ePave and Whitmyer is sustained.
- The rejection of claims 15-17 under 35 U.S.C. § 103(a) as unpatentable over ePave and XML Template is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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Address

Appeal 2009-009582
Application 09/872,764

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